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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/732,960	12/11/2003	Graham N. Pearce	555255012668	9286
33787	7590	09/19/2005		
JOHN J. OSKOREP, ESQ. ONE MAGNIFICENT MILE CENTER 980 N. MICHIGAN AVE. SUITE 1400 CHICAGO, IL 60611			EXAMINER EKONG, EMEM	
			ART UNIT 2681	PAPER NUMBER

DATE MAILED: 09/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/732,960

Applicant(s)

PEARCE, GRAHAM N.

Examiner

EMEM EKONG

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/11/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless – (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claims 1-8 and 10** are rejected under 35 U.S.C. 102(e) as being anticipated by U.S Publication No. 2002/0165012 A1 to Bilhan Kirbas (Kirbas et al.).

Regarding claim 1, Kirbas et al. discloses in a wireless communication device, a method of providing restrictions on long distance calls from the wireless communication device comprising the acts of (abstract, figures 1 and 2, and paragraphs 0001-0005):

receiving, over a wireless link, long distance call restriction information from a host computer(paragraphs 0003, 0006 lines 6-11, and 0026 lines 5-7);

storing the long distance call restriction information (see figure 1, and paragraph 0006 lines 11-13);

determining, at the wireless device, whether a call attempt from the wireless device is restricted by the long distance call restriction information (paragraph 0006 lines 17-21);

if the call attempt is restricted by the long distance call restriction information, restricting the call attempt from the wireless device (paragraph 0007); and

if the call attempt is not restricted by the long distance call restriction information, allowing the call attempt from the wireless device (paragraph 0007).

Regarding claim 2, Kirbas et al. discloses the method of claim 1, comprising the further acts of:

receiving a telephone number via a user interface of the wireless communication device which represents the call attempt (see figure 1, and figure 2 step 220, and paragraph 0022);

identifying a country code or area code in the telephone number (paragraph 0022 lines 5-8); and

determining, at the wireless device, whether the call attempt is restricted based on the country code or the area code and the stored long distance call restriction information (paragraph 0022 lines 8-10).

Regarding claim 3, Kirbas et al. discloses the method of claim 1, comprising the further acts of:

receiving a telephone number via a user interface of the wireless communication device which represents the call attempt (see figure 1, figure 2 step 220, and paragraph 0022);

identifying a country code or area code in the telephone number (paragraph 0022 lines 5-8);

determining, at the wireless device, whether the call attempt is restricted based on the country code or area code and the stored long distance call restriction information (paragraph 0022 lines 8-10); and

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if the call attempt is restricted, providing a call restriction alert indication at the wireless communication device (paragraphs 0008, and 0023).

Regarding claim 4, Kirbas et al. discloses the method of claim 1, comprising the further acts of:

receiving a telephone number via a user interface of the wireless communication device which represents the call attempt (see figure 1, figure 2 step 220, and paragraph 0022);

identifying a country code or area code in the telephone number (paragraph 0022 lines 5-8);

comparing the country code or area code with one or more allowable/disallowable codes indicated by the stored long distance call restriction information (paragraph 0006 lines 17-21); and

if the call attempt is restricted, providing a call restriction alert indication at the wireless communication device (paragraph 0008).

Regarding claim 5, Kirbas et al. discloses a wireless communication device, comprising:

a radio modem which receives long distance call restriction information from a host computer (paragraph 0006 lines 6-11, and paragraph 0026 lines 5-7);

memory which stores the long distance call restriction information (paragraphs 0003, and 0006 lines 11-13);

a user interface which receives a telephone call attempt from an end user of the wireless device (see figure 1, figure 2 step 220, paragraph 0006 lines 13-17, and paragraph 0022);

a controller which: determines whether the call attempt is restricted by the long distance call restriction information (see figure 1, figure 2 step 250, paragraph 0006 lines 17-21, and paragraph 0022);

if the call attempt is restricted by the long distance call restriction information, restricting the call attempt from the wireless device (paragraphs 00022 and 0023); and

if the call attempt is not restricted by the long distance call restriction information, allowing the call attempt from the wireless device (paragraphs 00022 and 0023).

Regarding claim 6, Kirbas et al. discloses the wireless device of claim 5, wherein the controller further:

receives a telephone number via the user interface of the wireless communication device which represents the call attempt (see figure 1, figure 2 step 220, and paragraph 0022);

identifies a country code or area code in the telephone number (paragraph 0022 lines 5-8); and

determines whether the call attempt is restricted based on the country code or the area code and the stored long distance call restriction information (paragraph 0022 lines 8-10).

Regarding claim 7, Kirbas et al. discloses the wireless device of claim 5, wherein the controller further:

receives a telephone number via the user interface of the wireless communication device which represents the call attempt (see figure 1, figure 2 step 220, and paragraph 0022);

identifies a country code or area code in the telephone number (paragraph 0022 lines 5-8);

determines whether the call attempt is restricted based on the country code or the area code and the stored long distance call restriction information (paragraph 0022 lines 8-10); and

if the call attempt is restricted, providing for a call restriction alert indication (paragraphs 0008, and 0023).

Regarding claim 8, Kirbas et al. discloses the wireless device of claim 5, wherein the controller further:

receives a telephone number via the user interface of the wireless communication device which represents the call attempt (see figure 1, figure 2 step 220, and paragraph 0022);

identifies a country code or area code in the telephone number; comparing the country code or area code with one or more allowable/disallowable codes indicated by the stored long distance call restriction information; and if the call attempt is restricted, providing for a call restriction alert indication (paragraphs 0008, 0022 and 0023).

Regarding claim 10, Kirbas et al. discloses the wireless device of claim 5, further comprising: a smart card interface for receiving a smart card; and wherein the

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radio modem receives long distance call restriction information of a user profile which uniquely corresponds to an identifier stored on the smart card (see figure 1, and paragraph 0017):

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. **Claims 9^{II}, and 13-16** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirbas et al. in view of U.S. Patent No. 6,081,731 to David Boltz (Boltz et al.).

Regarding claim 9, Kirbas et al. discloses the wireless device of claim 5, however fails to disclose further comprising: wherein the radio modem receives long distance call restriction information of a user profile which uniquely corresponds to a mobile or subscriber identifier stored in the wireless device.

Boltz et al. discloses the wireless device wherein the radio modem receives long distance call restriction information of a user profile which uniquely corresponds to a mobile or subscriber identifier stored in the wireless device (col. 2 line 63 - col. 3 line 9, and col. 5 lines 33-51).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the wireless device of Kirbas et al. with the device of Boltz et al. whose radio modem receives long distance call restriction information of a user profile which uniquely corresponds to a mobile or subscriber for the purpose of obtaining information for call restriction usage.

Regarding claim 11, Kirbas et al. discloses a communication system, comprising: the wireless communication device including: a radio modem which receives the long distance call restriction information; memory which stores the long distance call restriction information; a user interface which receives a telephone call attempt from the subscriber of the wireless device; a controller which: determines whether the call attempt is restricted by the long distance call restriction information; if the call attempt is restricted by the long distance call restriction information, restricting the call attempt from the wireless device; and if the call attempt is not restricted by the long distance call restriction information, allowing the call attempt from the wireless device (see figure 1, figure 2 step 220, and paragraph 0022).

However, Kirbas et al. fails to disclose a host computer network; memory in the host computer network; the memory for storing user profile information which is unique

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to a wireless communication device or a subscriber thereof; the user profile information including long distance call restriction information;

the host computer network configured to transmit the long distance call restriction information to the wireless communication device through a wireless communication network.

Boltz et al. discloses a host computer network; memory (i.e. HLR, and VLR) in the host computer network; the memory for storing user profile information which is unique to a wireless communication device or a subscriber thereof; the user profile information including long distance call restriction information (col. 2 line 63 - col. 3 line 9, and col. 3 line 54 – col. 4 line 11);

the host computer network configured to transmit the long distance call restriction information to the wireless communication device through a wireless communication network (see figure 5, and col. 5 lines 33-58).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Kirbas et al. with the host computer network; and memory for storing user profile information which is unique to a wireless communication device or a subscriber of Boltz et al. for the purpose of storage space for the host computer for information accessibility in call restricting.

Regarding claim 13, the combination of Kirbas et al. and Boltz et al. discloses the communication system of claim 11, wherein the controller of the wireless device further: receives a telephone number via the user interface of the wireless device which represents the call attempt; identifies a country code or area code in the

telephone number; determines whether the call attempt is restricted based on the country code or the area code and the stored long distance call restriction information; and if the call attempt is restricted, providing for a call restriction alert indication (Kirbas et al., see figures 1, and 2 step 220, and paragraphs 0008, 0022 and 0023).

Regarding claims 14, and 15, Kirbas et al. discloses a wireless communication device, a method of providing restrictions on long distance calls from the wireless communication device comprising the acts of: receiving, from a user interface of the wireless device, a plurality of telephone call digits of a telephone number (reads on claim 14) (see figures 1, and 2, and paragraphs 0006, 0021, and 0022).

However, Kirbas et al. fails to disclose transmitting, to a host computer network, a query request to identify whether a telephone call to the telephone number should be restricted based on long distance call restriction information stored in the host computer network; receiving, from the host computer network, a response to the query request; if the response is positive, allowing the telephone call; if the response is negative, restricting the telephone call and providing an audible or visual alert at the wireless device (claim 14);

transmitting the query only if the telephone number is identified as being a long distance telephone number (claim 15).

Boltz et al. discloses transmitting, to a host computer network, a query request to identify whether a telephone call to the telephone number should be restricted based on long distance call restriction information stored in the host computer network (col. 2 lines 63 – col. 3 lines 29, and col. 3 lines 65 – col. 4 line 11); receiving, from the host

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computer network, a response to the query request; if the response is positive, allowing the telephone call; if the response is negative, restricting the telephone call and providing an audible or visual alert at the wireless device (reads on claim 14) (col. 2 line 63 - col. 3 line 29, and col. 3 line 54 – col. 4 line 29, and col. 5 lines 40-45);

transmitting the query only if the telephone number is identified as being a long distance telephone number (reads on claim 15) (col. 3 lines 65- 67, and col. 5 lines 64- 67).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the wireless device of Kirbas et al. with the device of Boltz et al. for the purpose of obtaining information based on stored information in the host computer for call restricting.

Regarding claim 16, Kirbas et al. discloses a wireless communication device which is attempting to place a telephone call to a telephone number.

However, Kirbas et al. fails to disclose in a server of a computer network, a method of providing restrictions of long distance calls from a wireless communication device comprising the acts of: maintaining storage of long distance call restriction information in a user profile; receiving a query request from a wireless communication device which is attempting to place a telephone call to a telephone number, where the query request includes data indicative of a country code or area code of the telephone number; in response to the query request, searching the long distance call restriction information to identify whether the telephone call with the country code or area code

should be allowed or restricted; and transmitting a response to the wireless device as to whether the telephone call is allowed or restricted.

Boltz et al. discloses a server of a computer network (i.e. HLR, and VLR), a method of providing restrictions of long distance calls from a wireless communication device comprising the acts of:

maintaining storage of long distance call restriction information in a user profile (col. 2 line 63 - col. 3 line 16, and col. 3 lines 65 – col. 4 line 11); receiving a query request from a wireless communication device which is attempting to place a telephone call to a telephone number, where the query request includes data indicative of a country code or area code of the telephone number(col. 3 lines 1-19); in response to the query request, searching the long distance call restriction information to identify whether the telephone call with the country code or area code should be allowed or restricted; and transmitting a response to the wireless device as to whether the telephone call is allowed or restricted (col. 2 line 63 - col. 3 line 29, col. 3 line 54 – col. 4 line 29, and col. 5 lines 40-45).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the wireless device of Kirbas et al. with the device of Boltz et al. for the purpose of obtaining information based on stored information in the host computer for call restricting.

4. **Claim 12** is rejected under 35 U.S.C. 103(a) as being unpatentable over Kirbas et al. in view of Boltz et al. as applied to claim 11 above, and further in view of U.S Patent No. 5678195 to Rauno Suikkola (Suikkola et al.).

The combination of Kirbas et al. and Boltz et al. discloses the communication system of claim 11, however the combination fails to disclose further comprising: a private network which includes the host computer.

Suikkola et al. discloses the communication system comprising: a private network which includes the host computer (database) (see figures 1 and 2).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combination with further teachings of Boltz et al. for the purpose of utilizing a private network.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited to further show the state of the art with respect to communication method:

U.S. Pat. No. 4908848 to Tetsuya Hanawa (Hanawa)

U.S. Pat. No. 5436957 to Von K. McConnell (McConnell)

U.S. Pat. No. 5742905 to David Matthew Pepe (Pepe et al.)

U.S. Pat. No. 5815808 to Eric Lee Valentine (Valentine)

U.S. Pat. No. 5960338 to George Foti (Foti)

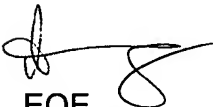
U.S. Pat. No. 6137877 to Bruce Robin et al..


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to EMEM EKONG whose telephone number is 571 272 8129. The examiner can normally be reached on 8-5 Mon-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOSEPH FEILD can be reached on 571 272 4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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9/15/05